

REMARKS

By this Amendment, Applicant amends claims 1, 11, 17, 22, and 29 to more appropriately define the present invention and adds new claims 36 and 37. Support for the claim amendments may be found at, for example, pages 6-9 of Applicant's specification. Claims 1-26, 28-33, and 35-37 are now pending in this application.

In the Office Action,¹ the Examiner rejected claims 1, 2, 4, 5, 8-11, 13, 14, 16, 17, 19, 21-26, 28-33, and 35 under 35 U.S.C. § 103(a) as obvious over Chern et al. (U.S. Patent No. 6,381,465) in view of Angles et al. (U.S. Patent No. 5,933,811); rejected claim 3 under 35 U.S.C. § 103(a) as obvious over Chern in view of Angles and further in view of Atsmon et al. (U.S. Patent No. 6,607,136); rejected claims 6, 15, and 20 under 35 U.S.C. § 103(a) as obvious over Chern in view of Angles and further in view of Bezos et al. (U.S. Patent No. 6,029,141); and rejected claims 7, 12, and 18 under 35 U.S.C. § 103(a) as obvious over Chern in view of Angles and further in view of Matsumoto et al. (U.S. Patent No. 6,484,946).

Applicant respectfully traverses the rejection of claims 1, 2, 4, 5, 8-11, 13, 14, 16, 17, 19, 21-26, 28-33, and 35 under 35 U.S.C. § 103(a) as obvious over Chern in view of Angles. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Claim 1 recites a method of wireless device advertising, including, among other things, "registering a wireless device to receive advertising messages by receiving a wireless device number that is input by a user from a website" and "re-formatting the advertising messages into an appropriate format corresponding to the wireless device." Chern and Angles, whether taken alone or in combination, do not disclose or suggest at least these features.

Chern discloses an alert or notification service. In the Chern system, a server sends an alert message to a user's handset in a Short Message Service (SMS) format. In addition, the Chern system may append promotional or advertising messages to the SMS alert message. See col. 3, lines 42-48. The Chern system, however, does not disclose or suggest "registering a wireless device to receive advertising messages by receiving a wireless device number that is input by a user from a website," as recited in claim 1. Instead, the Chern system retrieves from handset 130 information stored in the handset memory relating to a user. See col. 8, lines 36-40. The Examiner alleges this retrieval constitutes registering. See Office Action, pages 2-3. Applicant does not agree. The "retrieval" performed by Chern does not disclose or suggest "registering a wireless device to receive advertising messages by receiving a wireless device number

that is input by a user from a website,” as recited in claim 1. Instead, Chern merely discloses retrieving information stored in a handset memory.

Additionally, Chern does not disclose or suggest “re-formatting the advertising messages into an appropriate format corresponding to the wireless device.” Instead, Chern discloses appending advertising or promotional messages to alert messages that are generated when a user selects a notification or alert service. See col. 13, lines 24-26. The Chern system sends these advertising or promotional messages in SMS (Short Message Service) format as text characters and appends the messages to the alert message. See col. 13, line 67 to col. 14, line 26. These messages, however, are not re-formatted “into an appropriate format corresponding to the wireless device,” as recited in claim 1. Nor does Chern suggest such a feature.

Angles does not make for up the above noted deficiencies of Chern. Using a consumer member code, Angles discloses that an advertisement provider may identify a consumer’s demographic profile and preferences, and then select an appropriate advertisement based on the profile. See col. 3, lines 54-61. That is, Angles merely discloses using consumer preferences and demographic information about the consumer. Furthermore, while an advertisement provider using the Angles system assigns a consumer a unique member code (col. 3, lines 18-28 and col. 17, lines 10-11), Angles fails to disclose or suggest “registering a wireless device to receive advertising messages by receiving a wireless device number that is input by a user from a website.” Instead, Angles merely assigns a new code to each member that has entered demographic information. Angles also fail to disclose or suggest “re-formatting the advertising messages into an appropriate format corresponding to the wireless

device,” as recited in claim 1. Therefore, for at least the above reasons, Chern and Angles, alone or in combination, fail to disclose or suggest all of the elements of claim 1.

Furthermore, when relying upon Angles, the Examiner alleged that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chern to include remunerating users for accepting advertising messages . . . because it would advantageously stimulate users to receive more advertisement messages.” See Office Action, page 3. While this might demonstrate a reason why users would accept advertisement messages, it does not establish any motivation for combining any form of remuneration with the system disclosed in Chern. To the contrary, the Examiner’s allegation is unsubstantiated by any factual evidence in the record, such as a competent prior art reference. In the absence of such a prior art reference, a *prima facie* case of obviousness has not been made and the Examiner should withdraw the rejection of claim 1 for at least this reason.

Applicant further respectfully notes that the required motivation to combine references must be found in the prior art. See M.P.E.P. § 2143. Here, not only has the Examiner failed to point to a motivation found in Chern to remunerate a user for receiving advertisements, but Chern also teaches away from such a combination because it discloses appending advertising messages to alert messages. In particular, Chern’s teachings are contrary to the Examiner’s conclusion because the primary focus of Chern is sending alert messages, which include an advertisement only when the alert message is short enough to include the extra characters needed for the advertisement. See col. 14, lines 25-30. The decision whether to send advertisements is based upon whether there is enough space available in the alert message to include an

advertisement. Therefore, a user of Chern's system decides whether or not to receive alert messages, and does not make a decision to receive advertisements. Accordingly, the Examiner has not demonstrated a motivation for combining Chern and Angles, and these references do not show that there would be any reasonable expectation of success from such a combination. For at least the above reasons, the Examiner should withdraw the rejection of claim 1 and allow the claim.

Independent claim 11 recites, among other things, "re-formatting the advertising message into an appropriate format corresponding to the wireless device." As discussed above, Chern and Angles do not disclose or suggest at least this feature. Accordingly, the Examiner should withdraw the rejection of claim 11.

Independent claims 17, 22, and 29 include recitations of a scope similar to that of claim 11. These claims are neither disclosed nor suggested by Cherns and Angles, taken alone or in combination. Claims 17, 22, and 29 are thus allowable for at least the same reason discussed above and the Examiner should withdraw the rejection of these claims.

Claims 2, 4, 5, 8-10, 13, 14, 16, 19, 21, 23-26, 28, 30-33, and 35 depend from claims 1, 11, 17, 22, and 29. As explained above, claims 1, 11, 17, 22, and 29 are allowable over Chern and Angles. Accordingly, claims 2, 4, 5, 8-10, 13, 14, 16, 19, 21, 23-26, 28, 30-33, and 35 are also allowable at least because of their dependency from allowable claims. Applicant therefore requests that the Examiner also withdraw the rejection of dependent claims 2, 4, 5, 8-10, 13, 14, 16, 19, 21, 23-26, 28, 30-33, and 35 and allow the claims.

Furthermore, with regard to claims 4 and 19, the Examiner alleges that “information as to *additional air-time* is non-functional language and given no patentable weight.” See Office Action, page 5. Applicant disagrees. Claims 4 and 19 do not recite non-functional language because implementing the recited functions of these claims does require one to alter how the process steps are performed. Remunerating a user for air time requires the process to keep track of a different quantity than remunerating a user with a money value. Therefore, it is not merely functional language.

Applicant further objects to the Examiner’s allegations regarding non-functional language with regard to claims 4 and 19, and 24 and 31. Regarding claims 4 and 19, storing the advertisement messages in a second database also alters how the process steps are performed. Storing data in separate databases, for example, requires the process to operate differently to transmit or access the data. Similarly, regarding claims 24 and 31, which include recitations similar to claims 4 and 19, Applicant objects to the Examiner’s allegations for the reasons set forth above.

Applicant respectfully traverses the rejection of claim 3 under 35 U.S.C. § 103(a) as obvious over Chern in view of Angles and further in view of Atsmon. Claim 3 depends from allowable claim 1. As discussed above, Chern and Angles fail to disclose or suggest “registering a wireless device to receive advertising messages by receiving a wireless device number that is input by a user from a website” and “re-formatting the advertising messages into an appropriate format corresponding to the wireless device,” as recited in claim 1. Atsmon, which discloses an interactive authentication system that allows a consumer to interact with a base station to receive coupons and special sales offers from an electronic card, does not make up for the above noted deficiencies.

Accordingly, claim 3 is allowable over Chern, Angles, and Atsmon, and the Examiner should allow the claim.

Applicant respectfully traverses the rejection of claims 6, 15, and 20 under 35 U.S.C. § 103(a) as obvious over Chern in view of Angles and further in view of Bezos. Claims 6, 15, and 20 depend from allowable claims 1, 11, and 17, respectively. As discussed above, Chern and Angles do not disclose all of the features of claims 1, 11, and 17. While Bezos discloses an internet-based customer referral system, Bezos does not disclose or suggest at least “re-formatting the advertising messages into an appropriate format corresponding to the wireless device.” Accordingly, the Examiner should withdraw the rejection of claims 6, 15, and 20, and allow the claims.

Applicant respectfully traverses the rejection of claims 7, 12, and 18 under 35 U.S.C. § 103(a) as obvious over Chern in view of Angles and further in view of Matsumoto. Claims 7, 12, and 18 depend from allowable claims 1, 11, and 17, respectively. As discussed above, Chern and Angles do not disclose all of the features of claims 1, 11, and 17. Although Matsumoto discloses using an IC card to store application information such as amount information and point information, Matsumoto also does not make up for the above described deficiencies of Chern and Angles. Accordingly, the Examiner should withdraw the rejection of claims 7, 12, and 18, and allow the claims.

Finally, Applicant respectfully submits that new claims 36 and 37 are allowable over the applied prior art references at least due to their dependencies from allowable claims 1 and 11, respectively. Furthermore, the features of dependent claims 36 and 37

are neither disclosed nor suggested by the applied references, whether taken alone or in combination.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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